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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,614	12/08/1999	Timothy Peter Bonnert	T1481	1165

7590 09/22/2003
Patent Department
Merck & Co Inc
P.O. Box 2000
Rahway, NJ 07065-0907

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,614

Applicant(s)

BONNERT, TIMOTHY PETER

Examiner

Michael Brannock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) 2,3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Status of Application: Claims and Amendments

Applicant is notified that the amendments put forth in Paper 22, have been entered in full.

Claims 1-3, 5, 7-9 are pending and currently under examination.

Withdrawn Rejections/Objections:

Applicant is notified that any outstanding rejection that is not expressly maintained in this Office action has been withdrawn, specifically:

The rejection of claims 1, 3, 5, 7-9 as being anticipated by Caterina et al. at page 5 of the previous Office action, Paper 20, 8/23/02, and that of being anticipated by U.S. Patent No: 6335180 at page 6 of Paper 20 is withdrawn in view of Applicant's perfection of the priority claim to GB application 98270168. It is noted that the priority claim of U.S. Patent No: 6335180 to parent application 08915461 is not supported by a disclosure of SEQ ID NO: 35 in the 08915461 application.

New Rejections/Objections:

Drawings

The drawings are objected to as set forth in the attached Notice of Draftsperson's Patent Drawing Review (PTO-948). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

The disclosure is objected to because of the following informalities: the specification lacks a Brief Description of Drawings, 37 CFR 1.74. Applicant is further reminded that Figure 1, for example, contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). Such sequences require a sequence identifier in the form of SEQ ID NO: X. It is noted that a sequence depicted in a figure may be referenced with a sequence identifier either in the figure itself or in the Brief Description of the figure in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No: 6444440, which claims priority to the filing date of Application 09/132,316, see the Certificate of Correction, signed 3/11/2003.

U.S. Patent No: 6444440 discloses a polynucleotide encoding a polypeptide (SEQ ID NO: 2) which polypeptide is 100% identical to the instant SEQ ID NO: 2 although the U.S. Patent No: 6444440 SEQ ID NO: 2 comprises a 126 residue N-terminal extension relative to the instant SEQ ID NO: 2. Vectors and host cells comprising the polynucleotide are also described,

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see col 14. Further, 6444440 teaches the use of polynucleotide fragments to be used as probes comprising a polynucleotide fragment that consists of nucleic acid positions 1201 to 1250 of 6444440-1, such a probe would be 100% identical to the instant SEQ ID NO: 1 over the equivalent positions and would comprise the instant SEQ ID NO: 12 (1224-1244 of 6444440-1), see col 7.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Sambrook et al., Molecular Cloning, 1989. Claim 5 requires a fragment of a probe of SEQ ID NO: 4-19. SEQ ID NO: 9 has a 5'-deoxythymidine. Sambrook et al. disclose deoxythymidine, page C.10, that would be considered to be a fragment of SEQ ID NO: 9.

Claims 2 and 3 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Please note the new official fax number below:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.


Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



September 9, 2003



YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600